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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,689	05/26/2006	William Neill White	SWIN 3354	3794
7812 7590 02/22/2008 SMITH-HILL AND BEDELL, P.C. 16100 NW CORNELL ROAD, SUITE 220 BEAVERTON, OR 97006				
EXAMINER				
NORDMEYER, PATRICIA L				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
02/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,689

Applicant(s)

WHITE ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 5/26/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 – 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “a first layer of a non-affixing polymeric coating printed on the film, the non-affixing polymeric coating comprising a UV rotary letter press ink, and the first layer defining affixing regions providing a first pattern” in claim 1 is unclear, which renders the claim vague and indefinite. It is unclear from the specification and claim language how a non-affixing polymeric coating, which is the first layer, has affixing regions. How is the layer both affixing and non-affixing?

The phrase “when the substrate is removed from the carrier film” in claim 3 is unclear, which renders the claim vague and indefinite. It is unclear from the specification and claim language where the substrate is located as it has not been previously mentioned in the construction of the claims.

The phrase “the second layer has a degree of adherability to the carrier which is greater than its degree of adherability to the support” in claim 5 is unclear, which renders the claim

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vague and indefinite. It is unclear from the specification and claim language how the second layer has a greater adherability to the carrier than the support when the second layer is not in contact with the support due to the adhesive layer.

Claims 2, 4 and 6 – 36 are also rejected under 35 U.S.C. 112 2nd paragraph due to their dependency on the above rejected claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 – 10, 13 – 32 and 34 – 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Banahan (USPN 6,659,507).

Banahan discloses a security label (Column 1, lines 11 – 12) comprising: a carrier film (Figure 1, #10); a first layer of a non-affixing polymeric coating printed on the film (Figure 1, #11), the non-affixing polymeric coating comprising a UV rotary letter press ink (Column 3, lines 1 – 11), and the first layer defining affixing regions providing a first pattern (Figure 1, #11, the gaps in the layer), said affixing regions being substantially devoid of the non-affixing polymeric coating (Figure 1, #11, the gaps in the layer); a second layer of an affixing material

comprising a plurality of affixing pigmented polymeric coatings to provide a second pattern on the label (Figure 1, #13; Column 3, lines 45 – 53); wherein regions of the second layer adhere to the carrier film via the affixing regions of the first layer (Figure 3); and the security label further comprises an adhesive to adhere the label to a support (Figure 1, #16) as in claim 1. As in claim 2, the first layer is less adherable to the carrier than the second layer (Figure 3). With regards to claim 3, when the substrate is removed from the carrier film, the affixing portion of the second layer remains adhered to the carrier film (Figure 3, #11, the gaps in the layer. Regarding claim 4, the first layer is substantially inadherable to the carrier film (Figure 3). As in claim 5, the second layer has a degree of adherability to the carrier which is greater than its degree of adherability to the support (Figure 3, #13). With regards to claims 6 - 10, the carrier film comprises a plastic polyester material, any other suitable polymeric material or paper, a light transmitting material and is transparent or translucent (Column 2, lines 64 – 67). Regarding claims 13 – 16, the first layer is formed of a light transmissive material, is transparent or translucent, clear and comprises a polymeric material (Column 3, lines 1 – 20). As in claims 17 and 18, the UV rotary letter press ink of the first layer comprises a short chain polymeric substance, having a three-dimensional lattice structure (Column 3, lines 1 – 11). With regards to claims 21 and 22, the second material comprises a UV rotary letter press ink, comprising a long chain polymeric substance, having a two-dimensional structure or the second material comprises a pigmented polymeric coating with a long chain polymeric structure (Column 3, lines 45 – 53). Regarding claims 23, 24 and 29, a release layer is provided on the second layer (Figure 1, #17), wherein the release layer comprises a liner, including an adhesive resistant material (Column 3, lines 57 – 63), wherein the release layer may be provided on the adhesive layer (Figure 1, #16 and 17). As in claims 25, 27 and 28,

an adhesive is provided on the release layer (Figure 1, #16), the adhesive being coated thereon and so that it can be transferred to the second layer (Figure 3, #16), wherein the adhesive comprises a hot melt adhesive curable by light (Column 3, lines 60 – 63). With regard to claim 26, a sealing layer is provided between the second layer and the adhesive to prevent movement of the adhesive into the second layer (Figure 1, #15). Regarding claims 30 and 31, a pattern layer is provided on the second layer and the adhesive material is provided on the pattern layer, wherein the pattern layer comprises a metallized material (Figure 1, #15; Column 3, lines 54 – 56). As in claim 32, the label further includes a removal layer to allow the carrier to be removed from the support (Column 4, lines 10 - 21), the removal layer being provided on a removal region of the second layer (Column 4, lines 10 – 21). With regard to claim 34 – 36, the second layer comprises a confuse pattern region to render unreadable any matter printed on the substrate (Figures 4A and 4B, #12), an identification layer is provided for identification purposes and the identification layer includes an activatable material which defines an identification pattern (Figures 4A and 4B, #12).

With regard to the limitations of the different affixing regions of the first layer have the shape of different letters, whereby words can be formed from said letters and the second layer comprises a plurality of pigmented polymer coatings, to allow printed matter in a desired pattern to be applied to the first layer as the second layer, it would have been an obvious matter of design choice to change the shape of the affixing regions and the color of the second layer since a modification would have involved a mere change in size of the of the affixing regions and the color of a layer. A change in size, color or shape is generally recognized as being within the

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level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). One of ordinary skill in the art would have been motivated to change shape of the affixing regions and the color of the second layer in order to change the visual attractiveness of the label. It is desirable to change the visual attractiveness of the label in order to make overall appearance more appealing to the consumer.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banahan (USPN 6,659,507) in view of Gosselin et al. (USPN 5,885,677).

Banahan discloses a security label (Column 1, lines 11 – 12) comprising: a carrier film (Figure 1, #10); a first layer of a non-affixing polymeric coating printed on the film (Figure 1, #11), the non-affixing polymeric coating comprising a UV rotary letter press ink (Column 3, lines 1 – 11), and the first layer defining affixing regions providing a first pattern (Figure 1, #11, the gaps in the layer), said affixing regions being substantially devoid of the non-affixing polymeric coating (Figure 1, #11, the gaps in the layer); a second layer of an affixing material comprising a plurality of affixing pigmented polymeric coatings to provide a second pattern on

the label (Figure 1, #13; Column 3, lines 45 – 53); wherein regions of the second layer adhere to the carrier film via the affixing regions of the first layer (Figure 3); and the security label further comprises an adhesive to adhere the label to a support (Figure 1, #16). However Banahan fails to disclose the carrier film having a thickness of less than 0.2mm, preferably less than 100 microns. the thickness is in the range of substantially 25 microns to substantially 50 microns and the removal layer comprises a silica compound.

Gosselin et al. teaches a security label having a carrier film made of polyester (Column 4, lines 30 – 32) having a thickness of 0.051 to 0.102 mm (Column 4, lines 39 – 40; equals substantially 50 microns) and a removal layer comprising a silica compound (Column 4, lines 43 - 49) for the purpose of forming a security label having an identifier pattern (Column 1, lines 48 - 50).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the carrier film having the desired thickness and a removal layer with a silica compound in Banahan in order to form a security label having an identifier pattern as taught by Gosselin.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-

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1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794